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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,340	12/13/2001	Shell S. Simpson	10008222-1	6165

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EXAMINER	
MURPHY, DILLON J	

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/021,340	SIMPSON ET AL.	
	Examiner	Art Unit	
	Dillon J. Murphy	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 December 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12/13/2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: System and Method for Form Processing Using Web-Based Printing Hosted on a Printing Device.

The disclosure is objected to because of the following informalities:

The application number of the incorporated reference titled "System and Method for Charging from Printing Services Rendered" is not included in the specification on page 15, line 16. The correct application number is 09/999,450.

Appropriate correction is required.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Block 900 of figure 9A. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the

filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flannery (US 6,594,405) and LeClair et al. (US 6,636,891), hereafter referred to as Flannery and LeClair.

Regarding claim 1, Flannery teaches a method for generating a form, comprising the steps of, receiving data to be included in a form to be printed (Flannery, col 2, ln 12-13, processor receives inputs), configuring the received data for printing on a form (Flannery, col 2, ln 13-16, overlays information on form to be printed on preprinted form, configures spacing and alignment), and facilitating printing of the form (Flannery, col 2, ln 20-21, user is able to print with a single print job without multiple incorrect iterations). Flannery does not disclose expressly the method of printing over a network. LeClair,

however, discloses the method of network printing (LeClair, col 3, ln 7-9, network printing comprises a mechanism for printing data provided by initiator).

Flannery and LeClair are combinable because they are from the same field of endeavor of printing systems and data control. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the method of LeClair comprising printing over a network with the method of Flannery comprising receiving, configuring, and facilitating printing of a form. The motivation for doing so would have been to allow multiple computer workstations or personal computers to share input and output devices (LeClair, col 1, ln 17-20), and was suggested by Flannery by teaching that the personal computer used in the system of form processing can be configured to run software over a network such as a private network or the internet (Flannery, col 3, ln 4-8). Therefore, it would have been obvious to combine LeClair with Flannery to obtain the invention as specified in claim 1.

Regarding claim 2, which depends from claim 1, the combination of Flannery and LeClair further teaches a method wherein the step of receiving data comprises receiving data with a web-based form processing service hosted by a printing device (LeClair, col 7, ln 55-59, printer hosts processing in embedded server, and col 8, ln 1-3, user invokes a browser connected to internet to submit information).

Regarding claim 3, which depends from claim 1, the combination of Flannery and LeClair further teaches a method wherein the step of configuring the received data comprises merging the received data with static form data (Flannery, col 3, ln 45-49, foreground information is merged onscreen with static background data).

Regarding claim 4, which depends from claim 1, the combination of Flannery and LeClair teaches a method further comprising storing an electronic copy of the form in a personal imaging repository of a user that initiated printing of the form (Flannery, col 3, ln 50-54, entire document is stored in nonvolatile memory. The electronic copy is stored on the user computer, associating storing operation with user).

Regarding claim 5, the combination of Flannery and LeClair further teaches a system for generating a form, comprising: means for receiving data to be included in a form to be printed via a network (Flannery, col 2, ln 12-13, processor receives inputs, with input means in figure 1: keyboard #29, pointing device #30, and image input device #22. Network is taught by LeClair, network #300 in Figure 3); means for configuring the received data for printing on a form (Flannery, col 2, ln 13-16, overlays information on form to be printed on preprinted form, configures spacing and alignment); and means for facilitating printing of the form (Flannery, col 2, ln 20-21, user is able to print with a single print job without multiple incorrect iterations. Printer #24 is shown in figure 1).

Regarding claim 6, which depends from claim 5, the combination of Flannery and LeClair further teaches a system wherein the means for receiving data comprises a web-based form processing service hosted by a printing device (LeClair, col 7, ln 55-59, printer hosts processing in embedded server, and col 8, ln 1-3, user invokes a browser connected to internet to submit information).

Regarding claim 7, which depends from claim 5, the combination of Flannery and LeClair teaches a system further comprising means for storing an electronic copy of the form in a personal imaging repository of a user that initiated printing of the form

(Flannery, col 3, ln 50-54, entire document is stored in nonvolatile memory #66 of figure 2. The electronic copy is stored on the user computer, associating storing operation with user).

Regarding claim 8, the combination of Flannery and LeClair further teaches a printing device, comprising: hard copy generation hardware; a processing device (LeClair, figure 4 shows detailed view of controller 360 in figure 3. In figure 4, processor #406 is shown); and memory (LeClair, figure 4, RAM #404, ROM #408, and Storage device #409) including an embedded network server, the server hosting a form processing service with which forms can be created and printed (LeClair, col 7, ln 55-59, printer hosts processing in embedded server. Processing occurs in server in printer to process images comprising documents and forms).

Regarding claim 9, which depends from claim 8, the combination of Flannery and LeClair teaches a printing device wherein the form processing service includes logic configured to present a form processing web site to a user (LeClair, col 7, ln 55-59, server (#310 of figure 3) may be embedded in printer. In col 6, ln 36-36, server is coupled to display, wherein display presents browser to user. Form processing is also displayed to user in Flannery, col 3, ln 45-49).

Regarding claim 10, which depends from claim 8, the combination of Flannery and LeClair teaches a printing device wherein the form processing service includes logic configured to store a copy of a form in a personal imaging repository of a user that initiated printing of the form (LeClair, col 6, ln 50-56, printer contains memory for storing images and programs. Also see Flannery, col 3, ln 50-54, wherein entire document is

stored in nonvolatile memory. The electronic copy is stored on the user computer, associating storing operation with user).

Claims 11-15, 19, 20, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Al-Hussein (US 5,809,167) and Flannery (US 6,594,405).

Regarding claim 11, Al-Hussein teaches a method of printing a document comprising the steps of accessing document imaging data from at least one store via a network (Al-Hussein, col 6, ln 12-16, files are accessed from network disk), retrieving the document imaging data from the at least one store, and printing the document imaging data (Al-Hussein, col 6, ln 22-25, method comprises retrieving the document image and associated text file and printing at a printer). Al-Hussein does not disclose expressly the method of printing form data, although form data falls under the category of a document. Flannery discloses printing of form image data (Flannery, col 1, ln 56-58), although printing the static image is not taught by Flannery, if the document in the case of Al-Hussein is a form, then the static and textual data are printed together.

Al-Hussein and Flannery are combinable because they are in the same field of endeavor of printing systems and data control. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the specific form printing method of Flannery with the methods of Al-Hussein comprising accessing, retrieving, and printing document data. The motivation for doing so would have been to efficiently and accurately be able to complete the fields of a blank form with a word processor (Flannery, col 2, ln 17-20), as well as to retrieve a document image and text

file for later printing (Al-Hussein, col 3, ln 51-55). Therefore, it would have been obvious to combine Flannery with Al-Hussein to obtain the invention as specified in claim 11.

Regarding claim 12, which depends from claim 11, the combination of Al-Hussein and Flannery further teaches a method wherein the at least one store comprises a graphic store and a composition store (Al-Hussein, col 7, ln 39-51, images and text are stored in memory).

Regarding claim 13, which depends from claim 11, the combination of Al-Hussein and Flannery further teaches a method wherein the at least one store is associated with an imaging service that is configured to facilitate form completion (Al-Hussein, col 7, ln 39-51, CPU associated with imaging service controls program instruction sequences which manipulate document images. As explained in the rejection of claim 11, the document of Al-Hussein covers the forms as taught by Flannery).

Regarding claim 14, which depends from claim 13, the combination of Al-Hussein and Flannery further teaches a method wherein the imaging source comprises a network-based form processing service (Al-Hussein, col 7, ln 39-51, networked CPU and program of Al-Hussein provides document processing service. Additionally see, Flannery, col 2, 12-16, processor provides processing service for alignment of form data on display).

Regarding claim 15, which depends from claim 11, the combination of Al-Hussein and Flannery further teaches a method wherein the step of accessing form imaging data comprises accessing imaging data through use of an imaging extension (Al-Hussein, col 7, ln 39-51, CPU associated with imaging service controls program instruction

sequences which access and manipulate document images. As explained in the rejection of claim 11, the document of Al-Hussein covers the forms as taught by Flannery. Program of Al-Hussein provides generating and mapping of client instructions).

Regarding claim 19, the combination of Al-Hussein and Flannery further teaches a system for printing a form, comprising: means for accessing form imaging data from at least one store via a network (Al-Hussein, col 6, ln 12-16, files are accessed from network disk. Files are stored in server #41 on network disk #42, while being accessed via network #31 in figure 4); means for retrieving the form imaging data from the at least one store and means for printing the form imaging data along with static form data as a hard copy form (Al-Hussein, col 6, ln 22-25, method comprises retrieving the document image and associated text file and printing at a printer. Printer is shown as printer, #45, in figure 4).

Regarding claim 20, which depends from claim 19, the combination of Al-Hussein and Flannery further teaches a system wherein the means for accessing form imaging data comprises an imaging extension (Al-Hussein, col 7, ln 39-51, CPU associated with imaging service controls program instruction sequences which access and manipulate document images. In figure 5, disk #75, where image and text files are stored, is interfaced with SCSI interface #76 to computer bus #61. As explained in the rejection of claim 11, the document of Al-Hussein covers the forms as taught by Flannery. Program of Al-Hussein provides generating and mapping of client instructions).

Regarding claim 24, the combination of Al-Hussein and Flannery further teaches a printing device, comprising memory (Al-Hussein, in figure 5, Personal Imagining Computer System #20, "PICS," comprises CPU #60, RAM Memory #79, ROM #77, and disk storage #75 for storing and executing instructions for image processing, col 7, ln 61-67 and col 8, ln 1-9), including logic configured to access form imaging data (As explained in the rejection of claim 11, the document of Al-Hussein covers the forms as taught by Flannery) from at least one store via a network (Al-Hussein, col 6, ln 12-16, files are accessed from network disk. Files are stored in server #41 on network disk #42, while being accessed via network #31 in figure 4), retrieve the form imaging data, and print the form imaging data along with static form data as a hard copy form (Al-Hussein, col 6, ln 22-25, method comprises retrieving the document image and associated text file and printing at a printer. Printer is shown as printer, #45, in figure 4).

Regarding claim 25, which depends from claim 24, the combination of Al-Hussein and Flannery further teaches a printing device wherein the logic comprises a network-based printing service (Al-Hussein, figure 4, printers #45, #20, and #56 are connected to LANs #32 and #46, respectively).

Regarding claim 26, which depends from claim 24, the combination of Al-Hussein and Flannery further teaches a printing device wherein the logic comprises an imaging extension that is configured to access the at least one store (Al-Hussein, col 8, ln 67 and continuing to col 9, ln 1-8, program of PICS includes logic for an imaging extension configured to access at least one store, i.e. the program has capabilities to

create, store, and access text files and associated image files from various storage media).

Claims 16-18, 21-23, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Al-Hussein (US 5,809,167) and Flannery (US 6,594,405) as applied to claim 15, 20, and 24 above, respectively, and further in view of LeClair et al. (US 6,636,891), hereafter referred to as Al-Hussein, Flannery, and LeClair.

Regarding claim 16, which depends from claim 15, the combination of Al-Hussein and Flannery teach a method of accessing, retrieving, and printing forms, as well as the method accessing imaging data through the use of an imaging extension, as explained in the rejection of claim 15 above. The combination does not teach a method wherein the imaging extension comprises part of a user browser. However, LeClair teaches a method wherein the imaging extension comprises part of a user browser (LeClair, col 8, ln 1-3, printing commands are issued from a browser over the internet).

Al-Hussein, Flannery, and LeClair are combinable because they are from a similar field of endeavor of printing systems and data control. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the method of LeClair of using an imaging extension comprising a user browser with the combined method of Al-Hussein and Flannery comprising accessing, retrieving, and printing forms, as well as the method accessing imaging data through the use of an imaging extension. The motivation for doing so would have been to provide a platform-independent method of allowing multiple computer workstations or personal computers to share input and output devices (LeClair, col 1, ln 17-20), and was suggested by

Flannery by teaching that the personal computer used in the system of form processing can be configured to run software over a network such as a private network or the internet (Flannery, col 3, ln 4-8). Therefore, it would have been obvious to combine LeClair with aforementioned combination of Al-Hussein and Flannery to obtain the invention as specified in claim 16.

Regarding claim 17, which depends from claim 15, the combination of Al-Hussein, Flannery, and LeClair teaches a method wherein the imaging extension comprises part of a network-based printing service (LeClair, col 7, ln 57-65, instructions issued to retrieve documents are sent by browser, col 8, ln 1-3, in network connected to printer (figure 3, I/O device #350 connected to network #300, browser is viewed in display #322, connected to server #310 and network).

Regarding claim 18, which depends from claim 17, the combination of Al-Hussein, Flannery, and LeClair teaches a method wherein the printing service is hosted by a printing device having an embedded server (LeClair, col 7, ln 55-59, printer hosts processing in embedded server. Processing occurs in server in printer to process images comprising documents and forms).

Regarding claim 21, which depends from claim 20, the combination of Al-Hussein, Flannery, and LeClair teaches a system wherein the imaging extension comprises part of a user browser (LeClair, col 8, ln 1-3, printing commands are issued from a browser over the internet).

Regarding claim 22, which depends from claim 20, the combination of Al-Hussein, Flannery, and LeClair teaches a system wherein the imaging extension

comprises part of a network-based printing service (LeClair, col 7, ln 57-65, instructions issued to retrieve documents are sent by browser, col 8, ln 1-3, in network connected to printer (figure 3, I/O device #350 connected to network #300, browser is viewed in display #322, connected to server #310 and network).

Regarding claim 23, which depends from claim 22, the combination of Al-Hussein, Flannery, and LeClair teaches a system wherein the printing service is hosted by a printing device having an embedded server (LeClair, col 7, ln 55-59, printer hosts processing in embedded server. In figure 3, server #310 may be embedded in I/O device #350. Processing occurs in server in printer to process images comprising documents and forms).

Regarding claim 27, which depends from claim 24, the combination of Al-Hussein, Flannery, and LeClair teaches a printing system further comprising an embedded server (LeClair, col 7, ln 55-59, printer comprises an embedded server. In figure 3, server #310 may be embedded in I/O device #350. Processing occurs in server in printer to process images comprising documents and forms).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Pennell et al. reference, US 6,910,179, filed November 9, 1999, is cited for teaching a method and system of filling out forms online and printing conventionally through a user's browser. The Suganuma et al. reference, US 4,542,378, filed March 11, 1982, is cited for teaching a system and method of form

processing wherein static and dynamic form data are merged together and printed together on a blank sheet of paper. Furthermore, the Yuasa et al. reference, US 5,878,198, filed December 19, 1995, is cited for teaching a system and method of form processing wherein static and dynamic information are also merged together for subsequent storage and printing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dillon J. Murphy whose telephone number is (571) 272-5945. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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